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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,326	11/28/2000	Matt Crosby	DIGIP013	5891

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PATENT LEGAL STAFF
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EXAMINER

PERUNGAVOOR, SATHYANARAYA V

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/725,326	Applicant(s) CROSBY ET AL.	
	Examiner Sath Perungavoor	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/08/02, 04/29/02</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed January 8, 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Following documents have not been submitted and hence forth not considered as of this office action.

1. EP 0621724A1
2. PCT W096/29818

Drawings

2. The drawings are objected to because Fig. 4 and Fig. 8.

Regarding Fig. 4, one of the host computers is labeled 202-n, but there is no reference to 202 in the discussion for Fig. 4 in the specification.

Regarding Fig. 8, an association between 826 and 828 is missing.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

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is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are:

1. Registered trademark symbols are deficient in the disclosure, for example, Kinkos (page 19, line 2).
2. Disclosure should be devoid of grammatical problems, for example "serve" (page 4, line 4).

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3. Title of the invention should be consistent through all parts of the disclosure. Title in the abstract is not consistent with one in the specification, a difference of "IN A COMMON FORMAT" is observed.

Items 1 and 2 of the above-mentioned inadequacies are repeated several times throughout the disclosure.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 2, 5-7, 13, 14 and 17-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-4, 6 and 7 of U.S. Patent No. 6,577,311. Although the conflicting claims are not identical, they are not patentably distinct from each other because they encompass subject matter, which if not inherent is at least obvious over each other.

Regarding claim 1, US 6,577,311 discloses:

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In a distributed computing system, a method of sharing a multi-media object between a first node and a second node, comprising (Col. 22 Lines 9-11):

at the first node, storing a digital negative of the multi-media object, wherein the digital negative represents the multi-media object at a first resolution and a first format (Col. 22 Lines 12-13);

modifying the digital negative to form a resultant image at a second resolution and a second format (Col. 22 Lines 14-19);

associating an edit list based on the modifying with the resultant image (Col. 22 Lines 14-19);

linking the edit list to the digital negative (Col. 22 Lines 23-24);

at the second node, fetching the resultant image (Col. 22 Lines 12-13);

determining an output resolution and an output format of the resultant image (Col. 22 Lines 14-19);

converting the resultant image to the determined output resolution and the determined output format (Col. 22 Lines 14-19); and

outputting the resultant image at the determined output resolution and output format (Col. 22 Lines 14-19).

Similarly, claim 2 of instant application encompasses claim 3 of the US patent.

Similarly, claim 5 of instant application encompasses claim 4 of the US patent.

Similarly, claim 6 of instant application encompasses claim 6 of the US patent.

Similarly, claim 7 of instant application encompasses claim 7 of the US patent.

Similarly, claim 13 of instant application encompasses claims 1 and 2 of the US patent.

Similarly, claim 14 of instant application encompasses claim 3 of the US patent.

Similarly, claim 17 of instant application encompasses claim 4 of the US patent.

Similarly, claim 18 of instant application encompasses claim 6 of the US patent.

Similarly, claim 19 of instant application encompasses claim 7 of the US patent.

5. Claims 1, 6, 7, 13, 18 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 8 and 9 of copending Application No. 09724780. Although the conflicting claims are not identical, they are not patentably distinct from each other because they encompass subject matter, which if not inherent is at least obvious over each other.

Regarding claim 1, provisional application 09724780 discloses:

In a distributed computing system, a method of sharing a multi-media object between a first node and a second node, comprising (Page 2 Lines 28-30):

at the first node, storing a digital negative of the multi-media object, wherein the digital negative represents the multi-media object at a first resolution and a first format (Page 2 Lines 24-25);

modifying the digital negative to form a resultant image at a second resolution and a second format (Page 2 Lines 10-11);

associating an edit list based on the modifying with the resultant image (Page 2 Line 22);

linking the edit list to the digital negative (Page 2 Line 22);

at the second node, fetching the resultant image (Page 2 Line 31);

determining an output resolution and an output format of the resultant image (Page 2 Lines 32-33);

converting the resultant image to the determined output resolution and the determined output format (Page 2 Lines 32-33); and

outputting the resultant image at the determined output resolution and output format (Page 3 Lines 3-4).

Similarly, claim 6 of instant application encompasses claim 8 of the copending application.

Similarly, claim 7 of instant application encompasses claim 9 of the copending application.

Similarly, claim 13 of instant application encompasses claims 1 and 2 of the copending application.

Similarly, claim 18 of instant application encompasses claim 8 of the copending application.

Similarly, claim 19 of instant application encompasses claim 9 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 11, 12, 13-18, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Open Prepress Interface-Version 2.0 (NPL document, see PTO-892) herein after referred to as OPI.

Regarding claim 1, OPI discloses a distributed computing system with a method of sharing a multi-media object between a first node and a second node, comprising (Pages 4, 17 and 21; OPI producer and consumers are networked in a distributed environment.):

at the first node (Pages 4 and 17; OPI Producer),

storing a digital negative of the multi-media object, wherein the digital negative represents the multi-media object at a first resolution and a first format (Page 6; MainImageID);

modifying the digital negative to form a resultant image at a second resolution and a second format (Pages 8 and 23; ImageCropRect);

associating an edit list based on the modifying with the resultant image (Page 23; Cited reference discloses the edit list code and the links the digital negative and resultant image.);

linking the edit list to the digital negative (Page 23; Cited reference discloses the edit list code and the links the digital negative and resultant image.);

at the second node (Pages 4 and 21; OPI Consumer),
fetching the resultant image (Pages 4, 21 and 23; OPI consumer of the cited reference would perform fetching the resultant image.);

determining an output resolution and an output format of the resultant image (Pages 7, 8 and 23; ImageDimensions and TIFFASCII Tag disclose the output resolution and format.);

converting the resultant image to the determined output resolution and the determined output format (Pages 7, 8 and 23; ImageDimensions and TIFFASCII Tag dictate the output resolution and format.); and

outputting the resultant image at the determined output resolution and output format (Page 25; Cited art is used with printers.); .

Regarding claim 2, OPI discloses a method as recited in claim 1 wherein the first resolution is a higher resolution than the second resolution (Page 6; MainImageID refers to the high resolution image and ImageFileName refers to the modified image that is of lower resolution.).

Regarding claim 3, OPI discloses a method as recited in claim 2, wherein the converting comprises:

if the determined output resolution is the second resolution, then outputting the resultant image at the second resolution (Page 25; Cited reference discloses outputting the resultant image at any resolution to the printer.).

Regarding claim 4, OPI discloses a method as recited in claim 3, wherein the converting further comprises:

if the determined resolution is a third resolution that is different than the second resolution, then fetching the edit list (Page 23; Disclosed reference shows three resolution conversions.);

fetching the digital negative linked to the edit list (Page 23; Cited reference discloses the fetching of image data for main image.);

operating on the digital negative to form the resultant image at the third resolution based upon the edit list (Page 23; Executing of the disclosed code by the OPI producer would perform the claimed function.).

Regarding claim 5, OPI discloses a method as recited in claim 3, wherein the first node is a first computing device coupled to a first input device and a first output device and wherein the second node is a second computing device coupled to a second output device and a second input device (Page 17, 21 and 25; Cited reference discloses

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servers, printers and workstations, it is commonly known that these devices would include input and output devices.).

Regarding claim 6, OPI discloses a method as recited in claim 5, wherein the first computing device and the second computing device are linked in a peer-to-peer arrangement (Page 4; Cited reference discloses the networking of OPI producers and OPI consumers.).

Regarding claim 11, OPI discloses a method as recited in claim 1, wherein the first format is selected from a group comprising: JPEG, TIFF, and PNG (Pages 6-7).

Regarding claim 12, OPI discloses a method as recited in claim 1, wherein the second format is selected from a group comprising: JPEG, TIFF, and PNG (Pages 6-7).

Regarding claim 13, all limitations are set forth and rejected as per discussion for claim 1.

Regarding claim 14, all limitations are set forth and rejected as per discussion for claim 2.

Regarding claim 15, all limitations are set forth and rejected as per discussion for claim 3.

Regarding claim 16, all limitations are set forth and rejected as per discussion for claim 4.

Regarding claim 17, all limitations are set forth and rejected as per discussion for claim 5.

Regarding claim 18, all limitations are set forth and rejected as per discussion for claim 6.

Regarding claim 23, all limitations are set forth and rejected as per discussion for claim 11.

Regarding claim 24, all limitations are set forth and rejected as per discussion for claim 12.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-10 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over OPI.

Regarding claim 7, OPI does not expressly disclose a method as recited in claim 5, wherein the first computing device and the second computing device are wirelessly linked.

Official Notice is taken that linking computing devices wirelessly is well known and expected in the art. Wireless links are a well-known version of networking and are used to give greater portability and are glaringly used in cellular phones, laptops and PDAs.

Regarding claim 8, OPI discloses a method as recited in claim 7, wherein the converting is performed at the second computing device (Pages 4, 21 and 23; OPI consumer (second computing device) executes the conversion processing code.).

Regarding claim 9, OPI discloses a method as recited in claim 8, wherein the multi-media object is a digital image formed of a plurality of pixels (Page 8).

Regarding claim 10, OPI discloses a method as recited in claim 9, wherein the converting is performed on a subset of the plurality of pixels based upon the edit list and the third resolution thereby preserving transmission resources required to link the first

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and the second computing devices (Pages 4 and 23; Cited reference discloses the minimization of network traffic and three resolution conversions.).

Regarding claim 19, all limitations are set forth and rejected as per discussion for claim 7.

Regarding claim 20, all limitations are set forth and rejected as per discussion for claim 8.

Regarding claim 21, all limitations are set forth and rejected as per discussion for claim 9.

Regarding claim 22, all limitations are set forth and rejected as per discussion for claim 10.

Contact Information

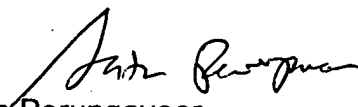
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sath Perungavoor whose telephone number is (703) 306-4116. The examiner can normally be reached on Monday to Friday from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta whose telephone number is (703) 308-5246, can be

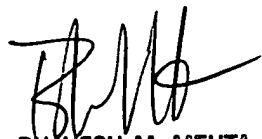
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reached on Monday to Friday from 9:00am to 5:00pm. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sath Perungavoor
Art Unit 2625
January 21, 2005



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